



DAC/DAW

Docket No.: SON-2968
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Minoru Kawahara

Application No.: 10/813,175

Confirmation No.: 4461

Filed: March 31, 2004

Art Unit: 2627

For: RECORDING/ REPRODUCING DEVICE AND
METHOD, RECORDING MEDIUM, AND
PROGRAM

Examiner: P. H. Gupta

PETITION UNDER 37 C.F.R. § 1.181
TO REQUEST WITHDRAWAL OF FINAL OFFICE ACTION

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

Applicant hereby petitions for withdrawal of finality of the Office Action of December 23, 2008.

Applicant, seeking review of the prematureness of the final rejection within the Final Office Action, respectfully requests reconsideration of the finality of the Office Action for the reasons set forth hereinbelow. See M.P.E.P. §706.07(c).

This is a petitionable issue because Applicant seeks review of the prematureness of the final rejection within that Office Action.

The "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" (emphasis added). M.P.E.P. §706.07(a).

ARGUMENT

The Final Office Action relies upon U.S. Patent Application Publication No. 2004/0027942 (Sako'942) in rejections under 35 U.S.C. §103.

35 U.S.C. §103(c)(1) provides as follows:

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Present application - The present application was filed after November 29, 1999.

Sony Corporation is the real party in interest of the present application. An assignment of all rights in the present application to *Sony Corporation* was executed by the inventor and recorded by the U.S. Patent and Trademark Office at reel 015678, frame 0806.

Sako'942- *Sony Corporation* is the real party in interest of Sako'942. An assignment of all rights in Satoh to *Sony Corporation* was executed by the inventor and recorded by the U.S. Patent and Trademark Office at reel 014365, frame 0065.

Common ownership - The present application and Sako'942 were, at the time the invention of the present application was made, commonly owned by Sony Corporation of Tokyo, Japan. But pursuant to 35 U.S.C. §103(c) and M.P.E.P §706.02(l)(1), Sako'942 is disqualified as prior art for the purpose of a rejection under 35 U.S.C. §103.

The Final Office Action acknowledges that Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same

entity as Sako et al. at the time this invention was made, or was subject to a joint research agreement at the time this invention was made (Final Office Action at page 7).

Nevertheless, the Final Office Action asserts that reference Sako et al. additionally *qualifies as prior art under another subsection of 35 U.S.C. 102*, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c) (Final Office Action as pages 7-8).

Here, **no rejection under 35 U.S.C. §102** can be found within the Final Office Action.

In this regard, the Final Office Action has concluded that **Sako does not teach:**

- Reading back data while the recording of said data by said recording means is in progress (Final Office Action at page 2);
- Verification means for verifying the recording on said information recording medium based on said data stored by said storage means (Final Office Action at page 5);
- Setting means for setting at least one of an exhaustion limit value parameter and a frequency limit value parameter of collective readout for said readout of said data by said readout means in accordance with a communication speed (Final Office Action at page 6);
- Selection means to select at least one of an exhaustion limit value parameter and a frequency limit value parameter of collective readout for said readout of said data by said readout means (Final Office Action at pages 6-7).

RELIEF

“If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.” M.P.E.P. §706.07(d).

Accordingly, Applicant hereby petitions the Commissioner under 37 C.F.R. §1.181 to direct the examiner to withdraw the finality of the Office Action mailed in the above-identified application on October 30, 2008.

FEES

No fee is believed required to support this petition. See 37 C.F.R. §1.181.

However, if any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: January 21, 2008

Respectfully submitted,

By  4/9, 2008

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